REMARKS

This Amendment is submitted in response to the Office Action mailed on June 11, 2008. Claims 1 - 19 are pending, and all stand rejected at present. Claim 20 has been cancelled.

Support for amendments to the claims is found at the following locations, and others.

Claim	Location of Support
1	Page 10, line 26
2	Page 3, lines 10 - 12
15	Page 7, lines 8 - 13
18, 19	Page 9, lines 5 - 22; page 19, line 23 et seq.

Amendments to other claims largely re-word the claims, so support is found in the original claims.

RESPONSE TO REJECTIONS

All claims were rejected as obvious, based on a Misawa reference.

Misawa Reference

Misawa shows a system for tracking and delivering packages, such as United Parcel Service, UPS, might use.

A customer places an order for an item with a merchant by

telephone. The merchant affixes an "IC tag" to the item (such as box B in his Figure 1), and also creates a computer file which contains data about the purchase, such as the customer's name and address, etc. It is possible that items in the file are also contained in the "IC tag." The merchant then sends the file to a shipper, such as UPS.

The shipper picks up the item from the merchant and, using the file, delivers the item to the customer. (Misawa: paragraphs 49, 50, and 52.)

The Invention

A microchip, or RFID (Radio Frequency Identification) tag, "tag" herein, is embedded into currency or other valuable documents. The tag contains data. When the currency is fed to an Automated Teller Machine, ATM, the ATM reads the data.

This arrangement allows the following functions to be implemented.

The tag can contain the serial number of the piece of currency in which the tag is embedded. Thus, one can determine whether the currency is counterfeit by comparing the serial number within the tag with the serial number printed on the currency.

Tag readers can read multiple tags positioned at a single location. Thus, if a stack of currency is presented to a tag reader, the tag reader can determine the number of pieces of

currency in the stack, by counting the number of tags read. Alternately, the tag reader can count the number of serial numbers read from tags.

Sometimes currency is intentionally damaged, to render it valueless. For example, if a robber attempts to steal currency from an armored car, guards in the armored car may dump chemical dye onto the currency. If the currency sheets have tags embedded in them, then the tags can later be read, to identify the currency.

The ATM can keep track of which customers deposited which currency, using the tags. That is, each tag in a piece of currency can contain a serial number. When a customer deposits currency into the ATM, the ATM reads the tags, and the serial numbers are stored in the customer's file. If the currency turns out to be counterfeit, then it is known which customer deposited it.

Initial Comment

MPEP § 2143.03 states:

> To establish _prima facie_ obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

Every claim contains recitations which are not found in Misawa.

Claim 1

Claim 1 recites an ATM, Automated Teller Machine, which includes a media acceptor for accepting sheet media. That is not seen in Misawa.

Claim 1(b) recites a tag reader, which reads tags contained in sheet media. Applicant points out that the "sheet media" is a particular type, namely, that which is "received" by the "media acceptor" in the ATM. That is not seen in Misawa.

Applicant points out that Misawa is 38 pages in length. 37 CFR § 1.104(c)(2) states:

> **When a reference is complex** or shows or describes inventions other than that claimed by the applicant, **the particular part relied on must be designated as nearly as practicable.**

Applicant requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO identify the following claim elements in Misawa:

the ATM;

the "media acceptor,"

the "wireless tag reader."

Claim 5

The discussion of claim 1 applies to claim 5.

In addition, Applicant points out that claim 5 states that an

ATM reads data from the tag, and presents the data to the user. That is not seen in Misawa. Applicant requests that this recitation be identified in Misawa.

Claim 6

Claim 6 states that the ATM receives a response from the user to the data presented to the user. That is not seen in Misawa, and Applicant requests that this recitation be identified.

Also, claim 6 states that the media is returned to the user if the transaction is cancelled. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 6 also states that the media is retained by the ATM if the user "proceeds with the transaction." This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 7

Claim 7 states that the identity of the user is stored with data read from the tags deposited. This allows the deposited media to be associated with the user at a later time.

This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 8

Claim 8 recites tracing certain media items to a depositor. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 8 also recites removing media items from the ATM. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 9

Claim 9 recites destroying value of valuable media items. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 9 also states that the valuable media items contain wireless tags, and that those valuable media items, containing wireless tags, are "defaced." This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 9 also states that the wireless tags are able to be read after defacement. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 10

Claim 10 states that the wireless tags in the defaced media items are read. This is not seen in Misawa, and Applicant requests

that this recitation be identified in the reference.

Claim 10 also states that the reading of the tags in the defaced items allows the value of the items to be determined. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 12

Claim 12 recites a storage facility for valuable media, which contains a tamper detection system. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 12 states that the storage facility contains a tag reader for reading tags in substrates. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 12 also states that, if tampering is detected, substrates are defaced. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 12 also states that the defacement does not destroy the tags. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claims 13 and 15

Claim 13 recites receiving sheet currency. This is not seen

in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 13 states that the sheet currency contains wireless tags. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 13 states that a "code" is contained in two locations: on the substrate and in the tag. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

This applies to claim 15

Claims 16 and 17

Claim 16 recites an ATM. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 16 states that the ATM dispenses media items to a user, which items contain wireless tags. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 16 states that the tags in the media items dispensed are read by the ATM. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 16 states that media items are dispensed, and then retracted. This is not seen in Misawa, and Applicant requests that

this recitation be identified in the reference.

Claim 16 states that the ATM reads the tags of the media items which are dispensed, and then reads the tags of the items which are retracted. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 16 states that discrepancies between the dispensed tags and the retracted tags are detected. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

This applies to claim 17.

Claim 18

Claim 18 states that an ATM supports a stack of media items. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 18 states that the media items contain tags. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 18 states that the ATM reads the tags. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Claim 19

Claim 19 states that an ATM counts items in a stack by reading

tags on the items. This is not seen in Misawa, and Applicant requests that this recitation be identified in the reference.

Dependent Claims

The dependent claims not addressed above are seen as patentable, based on their parents.

Response to Obviousness Rejection

The fact that the rejection is based on section 103 is an admission that all claim elements are not shown in the reference.

MPEP § 706.02(j) states:

> Contents of a 35 U.S.C. 103 Rejection
>
> . . . After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:
>
> **(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,**
>
> **(B)** the difference or differences in the claim over the applied reference(s),
>
> **(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and**
>
> **(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.**
>
> To establish a prima facie case of

obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The Office Action has failed to comply with this MPEP section. At best, the Office Action has complied with the **highlighted** passage, that is, the initial seven lines, but nothing more.

The Office Action has not shown the following, as required by this MPEP section:

-- the differences between the reference and the claims,

-- the modifications required to overcome the differences, and

-- a teaching as to why the modifications should be undertaken.

Further, this MPEP section explicitly states that the combined references must show all claim recitations. As explained herein,

Misawa does not do that.

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

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